

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated April 16, 2003, indicated that claims 1, 5, 6, 10-13, and 17-22 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 10, 21, 22 and 25-26 of U.S. Patent No. 6,488,405; claims 7, 8, 14, 17, and 23 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,488,405 in view of *Channin* (U.S. Patent No. 3,934,199); and claims 2-4, 9, 15, 16 and 24 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten.

Applicant appreciates the indication of allowability for claims 2-4, 9, 15, 16 and 24.

Applicant respectfully traverses each of the double patenting rejections because the Office Action fails to present the proper evidence to maintain the rejections.

With respect to the rejection of claims 1, 5, 6, 10-13, and 17-22 as being unpatentable over claims 1-3, 10, 21, 22 and 25-26 of U.S. Patent No. 6,488,405, the Office Action relies upon the erroneous argument that a near infrared laser beam is a polarized laser beam. A polarizer may be used in conjunction with a variety of light sources to polarize the light passing through the polarizer. An infrared laser beam defines light of a particular wavelength. Thus, an infrared laser beam is not necessarily polarized and should not necessarily be assumed to be polarized. Further evidence that rebuts this erroneous argument may be found in the attached three pages from the treatise, Fiber Optics Handbook (Michael Bass, ed., McGraw-Hill 2002) and by conducting an internet search based on the word-input criterion: unpolarized infrared; and unpolarized "near infrared". To the extent the Examiner is implicitly asserting an inherency argument, as explained below, the Office Action does not present support for maintaining such a rejection. Moreover, such a rejection is overcome by merely one instance that contradicts the asserted inherency argument, and Applicant has shown at least one such instance. Moreover, the Office Action has cited no evidence that would lend support for this

conclusion or of any equating correspondence between a near infrared laser beam and a polarized laser beam. As such, the record establishes that this conclusion is plainly wrong and that the rejection should be withdrawn.

The rejection of claims 1, 5-6, 10-13, 17-19 and 20-22 raises other erroneous inherency arguments that do not satisfy the legal standard. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q. 2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). As addressed more specifically below, the Office Action fails to provide the requisite evidence to support the inherency assertions.

Apparently addressing the subject matter recited in claim 12, the assertion directed to the '405 reference's laser scanning microscope ("LSM") inherently having a beam wavelength of about 1.3 microns is unsupported and erroneous. The Office Action does not provide any citations or other evidence to support this inherency conclusion. Near infrared light defines a specific band of wavelengths in the spectrum. The claimed LSM of the '405 reference does not inherently use a near infrared laser beam. For support and background information in this regard, reference may be made to http://www.kumc.edu/cic/laser_scanning_microscope.htm. Without any presentation of evidence to support the inherency assertion, the double patenting rejection cannot be maintained and Applicant accordingly requests that the rejection be withdrawn.

Apparently addressing the subject matter recited in claim 13, the inherency assertion directed to the '405 reference's microscope raster scanning laser light is unsupported and erroneous. The Office Action does not provide any citations or other evidence to support the inherency conclusion. The '405 reference does not claim raster scanning the die. The '405 reference further indicates that other commonly available microscopes can be used to image the circuitry as well. *See*, column 12, lines 33-34.

Without evidence to support the inherency assertion, the double patenting rejection cannot be maintained and Applicant accordingly requests that the rejection be withdrawn.

With respect to claims 18 and 19, the inherency assertions directed to varying the operation of the laser and, more specifically, pulsing the laser are also unsupported and erroneous. The Office Action does not provide any citations or other evidence to support the inherency conclusions and pulsing is a feature not available in all laser tools. See, e.g., <http://www.becker-hickl.de/pdf/spcmicr1.pdf>. Without evidence to support the inherency assertion, the double patenting rejection cannot be maintained and Applicant accordingly requests that the rejection be withdrawn.

With respect to the provisional rejection of claims 7-8, 14 and 23, the Office Action fails to present evidence of motivation in support of the modification of the '405 reference. An obviousness-type double patenting rejection is subject to the same requirements as an obviousness rejection under 35 U.S.C. § 103(a). See, M.P.E.P. § 1504.06. Evidence has not been provided of any teaching or suggestion for using the '405 reference in connection with using an image to identify the portion of circuitry that causes the liquid crystal to change phase and causing a portion of the liquid crystal to reach a temperature near its phase changing temperature threshold, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3 654, 57 U.S.P.Q. 2d 1161 (Fed. Cir., December 6, 2000). The Office Action fails to identify evidence of why one skilled in the art would be led to modify the '405 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejection be withdrawn.

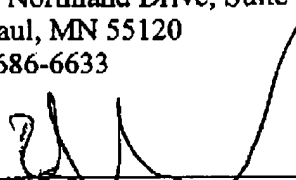
In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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By:


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Attachment: Fiber Optics Handbook 1.11-1.1, 4.15 (Michael Bass, ed., McGraw-Hill 2002).

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